

No. 22,679

JUN 19 1968

IN THE

**United States Court of Appeals
For the Ninth Circuit**

SPRING CREST COMPANY, a corporation, THOMAS
A. STUBBLEFIELD, JAMES F. BROOKS, and
JOHN H. HANCOCK,

Appellants,

vs.

AMERICAN BEAUTY PLEAT, INC., a corporation,
and ORVILLE T. STALL,

Appellees.

BRIEF FOR APPELLANTS

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BRIEF FOR APPELLANTS

(References in this brief to the Clerk's Transcript are designated as "Tr.", and references to the Reporter's Transcript of Proceedings during the trial are designated as "R". Throughout the brief, all emphasis is ours unless otherwise noted.)

STATEMENT OF JURISDICTION

This action was commenced in the United States District Court for the Southern District of California, Central Division (now the Central District of California) by the filing of a Complaint for Patent Infringement of United States Letters Patent No. 3,090,431 (Tr. 2). Jurisdiction in the District Court was conferred by 35 U.S.C. 281 and 28 U.S.C. 1338(a). A counterclaim for declaratory relief for invalidity and non-infringement of

Letters Patent No. 3,090,431 was filed, the District Court having jurisdiction thereover by virtue of 28 U.S.C. 1338(a) and 2201.

This Court has jurisdiction to review the judgment (Tr. 292) entered in the District Court by Judge Westover by virtue of 28 U.S.C. 1294(4), said judgment being a final judgment. A timely notice of Appeal from said judgment was filed (Tr. 298).

THE PARTIES

Appellants are the same parties as the plaintiffs in the District Court. Appellant Spring Crest Company (hereinafter referred to as "Spring Crest") is a California corporation, having its principal place of business in La Habra, California. Appellants Thomas A. Stubblefield, James F. Brooks and John H. Hancock are residents of King's Beach, Garden Grove and La Habra, California, respectively. Messrs. Stubblefield, Brooks and Hancock are the joint owners of the patent in suit No. 3,090,431 and Spring Crest is the exclusive licensee thereunder.

Appellees are the same as the defendants below. Appellee American Beauti Pleat, Inc. (hereinafter referred to as "Beauti Pleat") is a California corporation, having its principal place of business in Norwalk, California. Appellee Orville T. Stall is a resident of Whittier, California, and is the president of Beauti Pleat.

CONCISE STATEMENT OF THE CASE

Following the sending of written notices of infringement to defendants (R. 272), plaintiffs commenced this

action on August 23, 1965 by the filing of a complaint (Tr. 2) for infringement of Patent No. 3,090,431.

This patent (Exhibit 1) relates to drapery hardware used in the installation of spring-pleated draperies. The patent has four claims, claims 1 and 2 being directed to the particular construction of the glide and connector member shown in the patent. Claims 3 and 4 are directed to a combination of elements comprising a track member, an undulant spring, and glide and connector members which are secured to the spring and which ride in the track as the draperies are traversed between open and closed positions.

Defendants filed their answer (Tr. 13) on March 17, 1966, setting up defenses of invalidity, non-infringement indefiniteness, file wrapper estoppel and inequitable conduct on plaintiffs' part because of alleged harassment of defendants. At the same time, defendants by way of counterclaim (Tr. 17) sought a declaratory judgment of invalidity and non-infringement of the patent in suit, No. 3,090,431, and of each claim thereof. Plaintiffs' answer to the counterclaim (Tr. 20) was filed on April 5, 1966.

On May 24, 1966, in answer to defendants' Interrogatory No. 29, plaintiffs stated (Tr. 50) that claim 3 of the patent in suit was the only claim alleged to be infringed by defendants.

On July 12, 1966, defendants filed their pre-trial statement (Tr. 101) and set forth in the "Issues to be tried by Court" that the validity of patent No. 3,090,431 and particularly claim 3 thereof and the infringement of claim 3 were to be tried. The issue of patent misuse was

raised by defendants for the first time in this pre-trial statement.

In plaintiffs' Memorandum of Contentions of Fact and Law (Tr. 111, filed July 13, 1966 and refiled on November 28, 1966, Tr. 228), claim 3 of the patent in suit was the only claim referred to as being in issue.

On November 10, 1966, plaintiffs and defendants filed a Stipulation of Facts Agreed Upon (Tr. 216), which stipulation again referred only to claim 3 of the patent in suit.

A pre-trial conference was held on November 14, 1966 (Tr. 269) but no formal pre-trial order was entered by the Court.

Trial was held on June 7, 8 and 9, 1967. Following a recess, the trial was completed on October 10 and 11, 1967. On June 7, 1967, defendants asserted that claims 1, 2 and 4 of the patent in suit were in issue in addition to claim 3 (R. 11). On June 8, 1967, plaintiffs moved to dismiss defendants' counterclaim insofar as it pertained to claims 1, 2 and 4, which motion was denied (R. 163-166).

At the close of the testimony on October 11, 1967, the Court heard oral argument and held that plaintiffs' glide was not infringed by defendants' glide, that there was no invention in this case and the Court requested defendants to prepare findings accordingly (R. 668). Defendants asked the Court if it cared to make a finding on patent misuse and the Court answered "no" (R. 668).

Findings of Fact and Conclusions of Law (Tr. 270) and Judgment (Tr. 292) were thereupon prepared by defendants and adopted and entered by the Court holding

claims 1, 2, 3 and 4 of the patent in suit to be invalid and that plaintiffs were guilty of patent misuse.

From this the plaintiffs have appealed.

SPECIFICATION OF ERRORS

1. The District Court erred in holding claims 3 and 4 of Patent No. 3,090,431 invalid as defining aggregations or accumulations of old parts or elements, which, in aggregation, do not produce any new or different function or operation upon being brought together, and in which the whole does not exceed the sum of the parts.

2. The District Court erred in holding claims 3 and 4 of Patent No. 3,090,431 invalid as being obvious under 35 U.S.C. 103.

3. The District Court erred in adopting the portion of Finding of Fact No. 21 which states that "This was the first time that defendant Stall saw a Stubblefield glide."

4. The District Court erred in denying the motion to dismiss the counterclaim insofar as it related to claims 1 and 2 of Patent No. 3,090,431.

5. The District Court erred in holding claims 1 and 2 of Patent No. 3,090,431 invalid as being obvious under 35 U.S.C. 103.

6. The District Court erred in holding that appellants had misused Patent No. 3,090,431.

7. The District Court erred in not holding claim 3 of Patent No. 3,090,431 to be infringed if the claim is valid.

SUMMARY OF ARGUMENT

Claim 3 of the patent in suit sets forth a combination of elements used in the spring-pleated drapery art, namely, a track, undulant spring pleater and a plurality of glides to suspend the pleater from the track. The spring pleater and track are old elements, but the glides and the specific manner in which they coact with the spring pleater and track are new and fully set forth in the claim.

Claim 3 was held invalid from the bench at the conclusion of the trial. An analysis of the remarks made by the Court shows clearly that the Court did not apply the proper test of invention. The Court stated that it was not interested in the ordinary skill in the art and instead indicated that if elements in a claim are old and unchanged, per se, then a claim to the combination is improper.

Such a "test" is clearly contrary to this Court's decision in *Hensley Equipment Company v. Esco Corporation*, 375 F.2d 432, 1967, wherein a claim to a combination of elements, all old in the art, was held valid where there was a new coaction of the elements.

In the present case a new coaction exists. The invention achieves significantly superior and unexpected results. The Court acknowledged that there was no question but what it was an advance in the art.

Despite the fact that the Court was not interested in the ordinary skill in the art, findings prepared by appellees were adopted holding claim 3 to be invalid as being obvious to one of ordinary skill in the art. The record and evidence clearly show there is no credible basis for

this. The prior art devices actually in use were unsuccessful. The two prior art patents relied upon (one 25 years old and the other 73 years old) show a different type of drapery installation and disclose, as in *Hensley*, less than the entire combination claimed. A substitution of the elements disclosed in such patents into the claimed combination results in inoperative apparatuses. Appellee Stall, who had 21 years of experience in drapery hardware, could not tell with any certainty how devices of the prior art patents relied upon were designed to operate. Only with full knowledge of the present patent could he take a portion of these prior art patents, reconstruct them and put them into a new and different combination in order to arrive at something which would be the same as that claimed. This does not constitute obviousness.

The Court also held claims 1 and 2 of the patent to be invalid. There was no justiciable controversy with respect to these claims, and the claims are quite different in scope as compared to claims 3 and 4. No testimony was taken concerning these claims. No finding was made which adequately shows the reasoning of the Court upon which these claims are invalid. The holding of invalidity of these claims is unnecessary, improper and insufficient, and should be stricken.

The Court also held that patent misuse existed based upon an agreement of appellant Spring Crest to pay royalties upon drapery hardware parts, some patented, some not, for parts designed by appellant Stubblefield. There is no legal basis for such holding, and in fact it is plain from the record that there was no intention of the Court to find misuse.

ARGUMENT

BACKGROUND OF THE INVENTION

“(W)hat has been done here is very beneficial. I do not think there is any question about that. It is an advance in the art, and there is no question about that.” (R. 654)

These are the words used by the Court to describe the invention of the patent in suit.

The Stubblefield patent in suit No. 3,090,431 relates to the particular art of spring-pleated traverse drapery installations. The drawings of this patent are shown in Insert No. 1 opposite hereto. In general, spring-pleated draperies have a narrow strip of spring metal formed into a serpentine, or undulant, spring which is sewn into the upper hem of a drapery. Such a spring is shown in green on the patent drawings and is generally referred to as a “spring pleater”. The main functions of the spring pleater are to form uniform pleats in the drapery and to maintain such pleats as the drapery is pulled between its open and closed positions. The position of the spring pleater 11 shown in solid lines on Fig. 6 of the Stubblefield patent is that when the drapes are pulled to their open position (as in Fig. 1). The dotted line position of the spring pleater 11 in Fig. 6 illustrates the condition when the drapes are drawn closed.

Such installations in general also require a track (blue) and glides (red) of some sort which are connected to the spring pleater and which ride back and forth in the track to support the draperies as they are opened and closed.

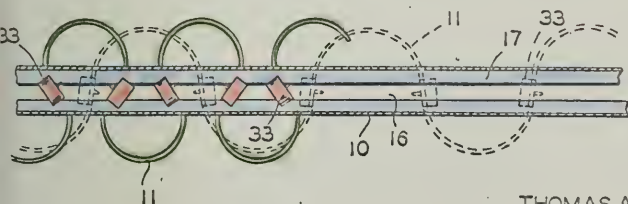
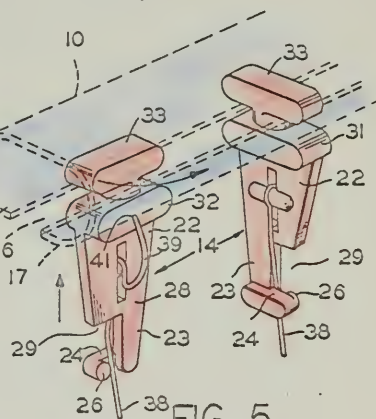
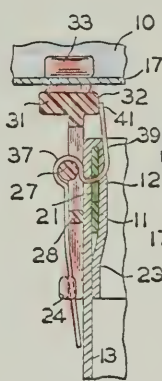
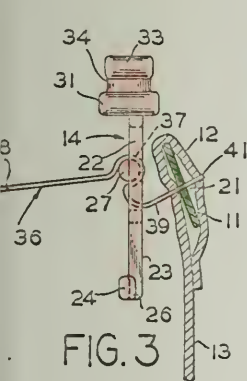
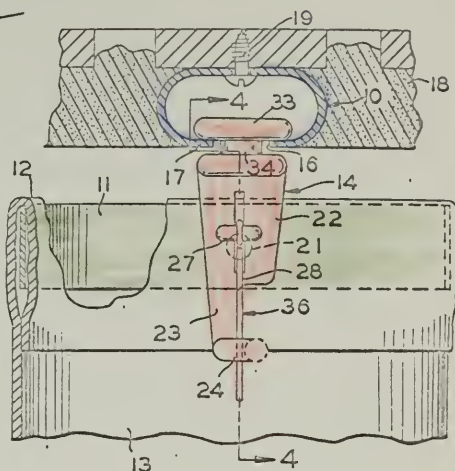
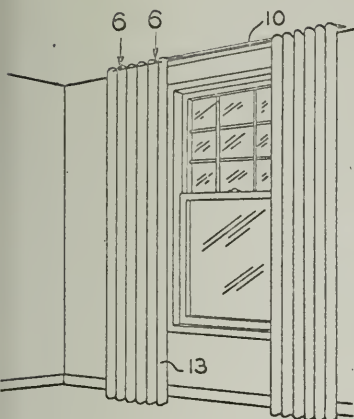
May 21, 1963

T. A. STUBBLEFIELD

3,090,431

DRAPERY SUPPORTING AND PLEATING APPARATUS

Filed March 29, 1961



INVENTOR.
THOMAS A. STUBBLEFIELD

BY *Richard H. Gurnsey*

ATTORNEY

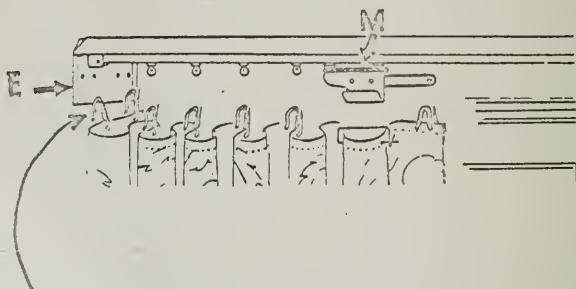
#613 Molded Nylon Ceiling
Snap-in Carrier. Can be
added or removed from track
without removing end pulleys.
Full pkg.: 1,000—500—100



#618 Nylon Ceiling Carrier
with heavy wire swivel eye-
let. Full pkg.—1000, 500,
100.



#608 One-piece Button Type
All-nylon Ceiling Carrier.
Full pkg.: 1,000—500—100



Pin-on Hooks

The use of spring-pleated draperies began in about 1946 when spring pleaters were first developed by appellee Stall (R. 470). Prior to the present invention, various glides had been used commercially to suspend the spring-pleated draperies from the tracks, the major varieties being those shown on Insert No. 2 on the opposite page, namely the one-piece button-type glide (#608, Ex. I), the nylon ceiling glide with heavy wire swivel eyelet (#618, Ex. I) and the one-piece Wilcox nylon snap-in glide (#613, Ex. I).

The one-piece button glides (#608) and wire eyelet glides (#618) must be inserted into the end of the track, generally in the shop when the track was assembled prior to delivering it to the job where it was to be installed (R. 34). The draperies were connected to the eyelets of the button glides by means of pin-on hooks shown on Insert No. 2 (Ex. 8). These hooks had one end thereof passing through holes formed in the spring pleater and through the upper hem of the drapery and the other end passing through an eyelet of the button glides.

This type of installation had several distinct disadvantages. First of all, the top of the drapery hung down from the track sufficiently far that some type of cornice was required to conceal traverse rod and the gap between the rod and the top of the drapery (R. 26, 33). Secondly, each pin-on hook had to be installed on the job, i.e., first secured to the drapery and then to an eyelet of a glide, which made for a very time-consuming operation (R. 33).

In order to overcome the hang-down gap and achieve a "close hook-up" arrangement so that the cornices could be eliminated, efforts were made to secure the spring-

pleated drapery directly to the wire eyelet of the button glides by means of a "pin and gripper" device (similar in principle to a tie pin that has a sharpened post sticking through the tie and shirt and held by a gripper engaging the end of the post (R. 35).)

This type of installation again had several distinct disadvantages. Whereas the pin-on hooks could be inserted through the spring pleater holes and drapery hem while the workman was on the floor, this could not be done with the pin and gripper method. Instead, the workman would have to mount a ladder, hold the draperies in one hand and with the other hand push the pin through the spring pleater hole, then through the eyelet of the glides which had previously been installed in the track, and then push the gripper member onto the end of the pin. Such a method was quite time-consuming (R. 37-39).

In addition, much trouble was encountered with the gripper members because they had an unfortunate tendency to fall off the pins so that the drapery came free from the glide. Such failure resulted in "call-backs" wherein the installer would have to send a workman back to the job to repin the drapery to the glides (R. 39). The cost of call-backs was absorbed by the installer (R. 47).

In an effort to solve these problems, the use of the Wilcox snap-in glide (#613, Ex. I) was adopted. These glides had the advantage that they could be installed, by pin and grippers, to the spring pleater while the workman was on the floor. After these glides had been secured to the drapery, the workman would then bring the upper hem of the drapery up to the track. The legs

of the glide would then be compressed together so that they could be inserted through the gap in the track, after which they would spring back and engage both sides of the track (R. 45).

Although the Wilcox glide eliminated the necessity of first installing the glides in the track, as was necessary with the button glides, it too had several distinct disadvantages in use. First of all, difficulty was experienced in compressing and inserting the legs of the glide through the track. Usually a tool, such as a screwdriver, was needed to compress the legs together so that the second leg would go through the track gap after the first leg had been inserted therein (R. 560). Secondly, it was found that tugs on the drapery, such as a child might give, after the drapery had been installed caused the Wilcox glide to pull out of the track. This again required service call-backs (R. 46). Thirdly, the pin and grippers used to secure the glides to the drapery had a tendency to come apart, as they had when used with the button glides (R. 46, 561).

It was this background of failures to achieve a satisfactory close hook-up spring-pleated drapery installation which led to the invention of the Stubblefield patent in suit.

Mr. Stubblefield, who at the time worked as a drapery installer, devised the glide shown in red on the patent drawings, Insert No. 1. This glide has a pin integral therewith which has an end adapted to pass through the spring pleater hole and drapery hem, the other end of the pin being then snapped into place on the body of the

glide to prevent accidental dislodgment of the glide from the drapery (R. 91).

The attachment of the glide to the drapery locks the glide thereto so that the head of the glide is held upright (R. 146). Also, the glide cannot turn about a vertical axis relative to the spring pleater but can only so turn if the spring pleater to which it was attached is flexed.

After all of the glides have been secured to the drapery, with one glide attached to each pleat of the drapery, the workman brings the upper hem of the drapery, with the heads of the glides pointing upwardly, up to the track. The heads of the glides are T-shaped, having a width slightly less than the width of the gap in the track and a length greater than the gap width.

Installation of the glides in the track is a very simple procedure, particularly as compared to the hardware previously used. Starting from one end of the drapery, the workman merely grasps the spring pleater in the drapery hem adjacent to a glide connected thereto, twists his wrist to flex the pleater to a position wherein the head of the glide is parallel to the track gap, moves the glide head up into the track and releases the pleater. The return of the flexed spring pleater to its normal position automatically turns the head of the glide so that the ends of the T-shaped heads ride in and on the track on opposite sides of the gap. Each glide would be inserted in the same way, with a simple twist of the wrist to flex the portion of the pleater to which the glide is attached so that it could be put into the track followed by a release of the pleater (R. 100-101).

Such installation does not require any handling of the glide at all, in contrast to all of the prior art spring pleater installations (R. 147).

After installation, the glides operate as follows: As the drapery is opened and closed, the spring pleater flexes and expands or contracts between the full and dotted-line positions of Fig. 6 of the patent in suit and the glides move along the track. The flexure of the spring causes the glides to turn in the track about a vertical axis, but the heads of the glides are so oriented to the spring pleater that even though the glides turn about a vertical axis, the heads will at all times be maintained by the spring pleater so that they are substantially cross-wise to the track gap and will ride on both sides of the track and not fall out.

If it is desired to take the draperies down for cleaning, release from the track again is a simple matter. Each section of the spring pleater to which a glide is secured is merely twisted to align the head of the glide with the gap in the track, and the weight of the drapery will pull the glide down free from the track. This action is repeated until all glides have been removed from the track.

In use, the invention has proven very successful. One unexpected advantage of the invention was that the glides could be attached to the draperies back in the workroom when the draperies were made up and then transported to the job with the glides already attached (R. 91, 100). This had been tried with prior glides, but unsuccessfully because the parts would not stay attached to the draperies during transport (R. 91, 92). Another unexpected

advantage of the invention resided in the fact that it was found that the glides did not have to be removed from the draperies during cleaning, an advantage not had by any of the prior devices (R. 144, 145).

Although it was anticipated that drapery installations could be made easily, it was found that installations could be made much more rapidly than the close hook-up installations previously made; in fact, about three times as fast (R. 141, 144).

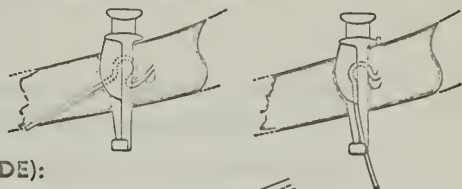
After the glide of the patent in suit had been sold by appellants for many months beginning in 1960 (R. 601), appellees designed and came on the market in May of 1961 with their version of the invention (Ex. AF). The specific design of the body portion of appellees' glide is somewhat different from that shown in the patent in suit. However, as the Court below stated, when appellees' or appellants' glides are used in combination with a spring pleater and track they "operate in exactly the same way" and "they produce exactly the same results, exactly" (R. 633). Appellants' and appellees' commercial devices are shown in Insert No. 3, opposite hereto.

Appellees were unstinting in their praise of the patented concept, as witness their remarks in the advertising of their product (Ex. AF):

"Beauti Pleat will soon introduce a brand new product. No more pin hooks! No more master carrier pins! New improved lock! Entirely new end plate! Plus many more advanced design features. Absolutely nothing else even similar to it is on the market! Our new slogan will be: 'Just a twist of the wrist'! We are field-testing it now here at Beauti

INSERTING PIN-ON GLIDE IN SPRING CREST PLEATER:

The pin-on glides are distributed along the pleater the same way as the pin-on hooks (above). Use pin-on hooks in both side hems for return-to-wall and center overlap. These pin-on hooks should be inserted 1" down from top of drapery.
NOTE: ALWAYS ATTACH GLIDE TO BACK SIDE OF DRAPERY AND PLEATER. INSERT THE SMALL END OF THE WIRE CLIP THROUGH PLEATER HOLE. ENGAGE LONG END OF CLIP INTO SLOT AT BOTTOM OF GLIDE AS ILLUSTRATED.



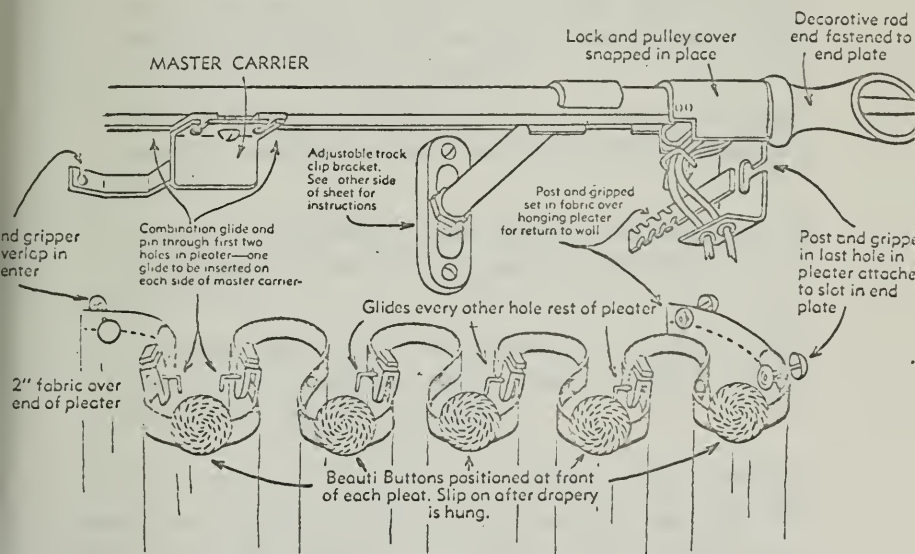
HANGING DRAPERIES (PIN-ON GLIDE):

Starting at the center of the rod, insert the glides of the first pleat on each side of the master carrier. Then insert remaining glides into the track of the Spring Crest Rod. To insert glide into track, (see illustration), grip pleat as shown. This will rotate the glide so that it will enter the track opening. Now PUSH UPWARD until it stops. Next, release pleater. Glide will turn and engage. Insertion is completed. Repeat this procedure for all glides except the last. This should be inserted into the slot between the cord pull and the track end cap. Finally, engage pin-on hook in the return bar and overlap bar at center.
NOTE: BE SURE TO PUSH EXCESS FABRIC AROUND TO RECESSED PLEATS TO PREVENT PUCKERING AT THE FRONT.



Exhibit 21 - Appellants' Commercial Device

COMBINATION GLIDE AND HOOK — No more loose pin-on hooks. Attach or detach from pleater (in heading of fabric) by simply pressing one side or the other of the built in pin. The glides slip into the track by merely twisting sideways and are held in place by tension of the pleater. The post (pin) with gripper which is used in end plate and return bar and also overlap bar can be attached before hanging drapery.



HANGING DRAPERY

Start with the first pleat by inserting a glide on each side of the master carrier. Snap the other glides in the track until you reach the last pleat where a post and gripper is used. It is fitted in the slot of the end plate. The post and grippers at the ends of the fabric fit the wall return bar and the overlap bar.

© 1961 American Beauti Pleat, Inc., Whittier, Calif.

Exhibit 28 - Appellees' Commercial Device



Pleat Nor. Cal. The reports are wonderful and our own staff is highly pleased and enthusiastic!

“This product will replace our ‘B’ hardware and will be the same price. * * *”

(The “B” hardware was appellees’ pin and gripper hardware (R. 339).)

The Court below likewise recognized the worth of the invention:

“I will admit that probably this has been a great advance in the art. I mean by that that these glides can be attached to the draperies in the shop, and they can be installed very easily by the operators when they go out to install them. All they have to do is to take the drapery to which has been connected the spring and the glide and insert it into the track. * * *” (R. 188-189)

“* * * although this seems to be a very small commodity, nevertheless they seem to be very valuable.” (R. 456)

“There is no question that that is advantageous. It is desirable. There is no question about that. * * *” (R. 638)

“I know that that is very desirable. I don’t think there is any question about that. I think it is an advance in the art.” (R. 648)

How, then, could the Court below have ruled from the bench that claim 3 of the patent in suit was invalid? We submit that the reason is that the Court applied an incorrect test of invention to the facts in this case. Although the proper test of invention is one of “obviousness” (and although there were subsequently adopted

findings and conclusions on this point, which are discussed hereinafter), it is clear that this test was not considered by the Court during final argument, in view of its remark:

“The Court: *I am not interested in the ordinary skill in the art.* I am just interested in whether or not the attaching of the glide, of the plaintiffs’ glide on the defendants’ glide, to the spring pleater is invention.”

THE DISTRICT COURT ERRED IN HOLDING CLAIMS 3 AND 4 OF THE PATENT IN SUIT INVALID AS DEFINING AN INVALID COMBINATION OF ELEMENTS. (SPECIFICATION OF ERROR NO. 1)

It is plain from the record that the chief, if not only, reason that claim 3 was held invalid was a belief on the part of the Court that the claim is to an improper combination of elements.

Claim 3 is as follows:

A drapery-supporting assembly, which comprises: an elongated undulant spring disposed in a horizontal plane and adapted to be mounted along the upper hem of a drapery to cause said drapery to assume a corresponding undulant shape; an elongated drapery track having two opposed track portions separated by a gap of predetermined width, said track portions and said gap being disposed generally in a horizontal plane and above said spring; a plurality of glide and connector means mounted at spaced points along said spring to slidably support the undulations of said spring from said track as said spring is extended and shortened during opening and closing of the drapery, each of said glide and connector means including an elongated shoe the width of which

in a horizontal plane is less than said predetermined gap width whereby said shoes may be passed upwardly and downwardly through said gap when in positions in substantial alignment therewith, the length of each of said shoes in a horizontal plane being substantially greater than said predetermined gap width whereby the end portions of said shoes will remain slidably supported on said opposed track portions when said shoes are in various positions substantially transverse to said gap, said shoes being disposed substantially transverse to said gap in supported relationship on said opposed track portions, each of said glide and connector means further including a connector portion connected with said shoe intermediate said end portions thereof, the connection between said connector portion and said shoe being adapted to prevent rotation of said connector portion relative to said shoe about a generally vertical axis, said connector portion extending downwardly through said gap and being sufficiently small in horizontal dimension that said shoe may rotate about a vertical axis between said position in substantial alignment with said gap and said positions substantially transverse thereto without effecting spreading apart of said opposed track portions, each of said glide and connector means further including means to connect said connector portion to said spring and to prevent substantial rotation of said connector portion relative to said spring about a generally vertical axis, said last-named means being so related to said connector portion, to said shoe and to said spring that said shoe will remain in said positions substantially transverse to said track despite movement of the undulations of said spring during normal extending and shortening of said spring to open and close the drapery; each of said

glide and connector means and the associated undulation of said spring being adapted to be manually twisted about a vertical axis to bring the associated shoe into substantial alignment with said gap for passing of said shoe through said gap during assembly or disassembly of said glide and connector means with said track.

(Claim 4 is dependent upon claim 3, and is essentially of the same scope except for additional limitations not utilized by appellees. Appellants did not charge appellees with infringing this claim, but the validity thereof should rise or fall with claim 3.)

For purposes of simplification, claim 3 can be broken down into three major elements: (a) an undulant spring (the spring pleater), (b) a track, and (c) a plurality of glides. Each glide has the following characteristics: an elongated shoe (the T-shaped head) having a width less than the track gap width and a length substantially greater than the track gap width so that the shoe will remain slidably supported by the track when the shoe is in various crosswise positions in the track, a connector portion affixed to the shoe so that it cannot turn relative to the shoe, and means to attach the connector portion to the spring pleater.

Claim 3 specifically relates the elements to each other so that the following results are obtained:

(1) The glides are connected to the spring pleater so that they cannot turn relative to the spring pleater about a vertical axis;

(2) The glides are turned in the track by the spring pleater without spreading the track gap;

(3) As the spring pleater contracts and expands during normal opening and closing of the draperies, it will move the glides along the track and will turn the glides, but at the same time the spring pleater will maintain the glides sufficiently crosswise of the track so they will not inadvertently fall out;

(4) The spring pleater can be manually twisted from its normal position to align the shoes with the track gap for installation or removal of the draperies.

In this combination, the track by itself is admittedly an old and unchanged element. Also, the spring pleater is admittedly an old and unchanged element. Further, the same track and the same spring pleater had been previously used in other combinations with glide and connector means, such as with the button glides and pin-on hooks or with Wilcox glides.

In the combination as set forth in claim 3, the only new elements, by themselves, are the particular plurality of glides. However, the claim sets forth with great preciseness the manner in which the spring pleater and track both cooperate with the glides and with each other to achieve the desired results enumerated above.

It is clear that the Court considered claim 3 to be fundamentally unpatentable because of the fact that the track and spring pleater were old elements. During the trial the Court made the following comments:

“There is no question that the track itself is old in the art. You cannot claim any priority on the track.” (R. 183)

“The spring is old in the art, so you cannot claim any priority for the spring.” (R. 183)

“The only thing new and the only thing that you can claim a priority on is the glide.” (R. 184)

“* * * the trouble is that you are taking your glide and you are combining it with things that are in the public domain, and then you are trying to claim a priority upon all the things that you have combined it with.

“Not only are you claiming a priority from the glide, but you are claiming a priority upon the things which the glide touches.” (R. 194)

At the time of final argument, the Court stated:

“Everything here is old in the art except possibly the glide which has been manufactured by the plaintiff. * * *” (R. 630)

“* * * you can’t claim anything from the spring pleater. There is nothing there that you have done that you have added to the spring pleater. You haven’t even added a hole to the spring pleater.” (R. 639)

The clear import from the above remarks is that the Court was of the belief that if several of the elements of a combination claim are old and unchanged, per se, then a claim to the combination cannot properly be made.

Such belief is, of course, contrary to law. As, for example, in *Hensley Equipment Company v. Esco Corporation*, 375 F.2d 432 (C.A. 9, 1967), claim 8 of the patent there in issue described a combination of twelve mechanical elements, *each old in the art*. This Court upheld the validity of the claim, stating that the first factor to be considered was whether claim 8 described a novel combination as compared to the prior art, and particularly

whether the features of the claim, while individually old in the art, coacted in the claimed combination to bring about a new result.

In the present matter there is a new cooperation between the admittedly old spring pleater and the new glides. The glides are secured to the spring pleater so that the heads of the glides are held upright at all times for insertion into the track. This is an important consideration, for it enables such insertion to be made without any necessity for handling the glides after they are attached to the drapery (R. 146). In the only other spring pleater installation in which the glides could be first attached to the drapery before the glides were inserted in the track (namely, the installations using the Wilcox glides), the glides could rotate about the pin and gripper connection to the drapery so that the head of the Wilcox glides would swing downwardly. As a result, it was necessary to handle such glides as they were inserted into the track (R. 147).

More importantly, the present glides and spring pleater cooperate with each other and with the track as the drapery is installed so that a mere twist of the pleater will enable the head of the glides to be aligned with the track gap in order that the heads can be inserted freely into the track, followed by a release of the pleater to bring the glides automatically to a position wherein they will not fall out of the track (R. 101). Such a cooperation is not found in any prior art combination. In a Wilcox installation, the split portions of the glides had to be compressed to get the glides into the track, and the spring-back of the glides themselves held the glides in the track.

Installations with button glides are, of course, completely different because the glides are already installed in the track and the draperies are hung therefrom.

There is a similar new cooperation between the elements of claim 3 in that draperies can be taken down in a reverse manner by a mere twist of the wrist applied to the spring pleater.

There is also a new cooperation between the spring pleater, glides and track after the draperies are hung and as they are opened and closed. As explained previously, the glides must turn about a vertical axis as they slide back and forth in the track during opening and closing of the draperies. The glides and track cooperate so that the glides can turn freely in the track without binding. The spring pleater cooperates with the glides and track so that during such opening and closing the glides are maintained by the pleater sufficiently crosswise of the track, even though turning therein, so that the glides do not fall out.

This function is new. In the prior art installations the glides (e.g., the button and Wilcox glides) could and did turn in the track as they moved back and forth along the track. However, these glides were designed so that they could be rotated through a full 360° turn without ever coming to a position wherein they could pass down through the track gap. As a consequence there was no necessity for connecting such glides to the spring pleater in such manner as to prevent rotation of the glides about a vertical axis relative to the spring pleater.

As has been discussed previously, the present invention had several unexpected results: the speed of installa-

tion was three times as great as previous methods, the glides could be installed on the draperies in the workroom and carried to the job, and the glide could be left in place on the draperies during cleaning thereof.

From the foregoing, it is quite evident that claim 3 sets forth a new combination of elements, even though the track and spring pleater per se are old. A new result has plainly been brought about, as recognized by the Court below: "What has been done here is very beneficial. I do not think there is any question about that. It is an advance in the art, and there is no question about that." (R. 654)

Quite plainly the Court below did not apply the proper test of combination claims, as set forth in *Hensley*, to claim 3 and the conclusion of invalidity as setting forth an aggregation should be reversed.

Parenthetically, it should be noted that the Court below was concerned about the effect of holding a claim to the combination valid in that it would withdraw from the public things which were in the public domain, namely, the track and spring pleater (R. 194). However, no such result would occur. The public is and would be free to use the track and spring pleater with any glides with which they had been used previously. Also, the track and spring pleater could be used with any glides that may hereafter be invented as long as such glides do not co-operate with the spring pleater and track in the very specific manner set forth in claim 3.

**THE DISTRICT COURT ERRED IN HOLDING CLAIMS 3 AND 4
INVALID AS BEING OBVIOUS. (SPECIFICATION OF ERROR
NO. 2)**

Although the Court was not "interested in the ordinary skill of the art" (R. 650), findings of fact were subsequently adopted holding that the invention of claim 3 did not define any invention and that it would have been obvious to one skilled in the art to substitute a glide substantially as shown in the Silverman patent No. 2,320,308 (Ex. K) or the Lounsbury patent No. 568,091 (Ex. M) for the glides previously used in the spring pleated drapery art (Findings of Fact Nos. 42 and 49, Tr. 283, 284).

It is submitted that the testimony and evidence simply do not support such findings, nor the conclusions of invalidity based thereupon.

**THE INVENTION OF CLAIMS 3 AND 4 IS NOT OBVIOUS IN
VIEW OF THE SILVERMAN PATENT NO. 2,320,308**

As pointed out previously, at the time of the present invention there was nothing commercially available which was successful for the purpose of making a close hook-up installation of spring-pleated draperies.

Nevertheless, after appellants had solved the problem, and after appellees came on the market with their "brand new" version of the invention to replace their existing hardware (Ex. AF), appellees took the position at the trial that the whole thing had been taught by the Silverman patent No. 2,320,308 (Ex. M).

The Silverman patent is shown on Insert No. 4 opposite hereto. As described in the Silverman patent, this

May 25, 1943.

J. Z. SILVERMAN

2,320,303

CURTAIN HOOK AND INSTALLATION

Filed Aug. 23, 1941

Fig. 1.

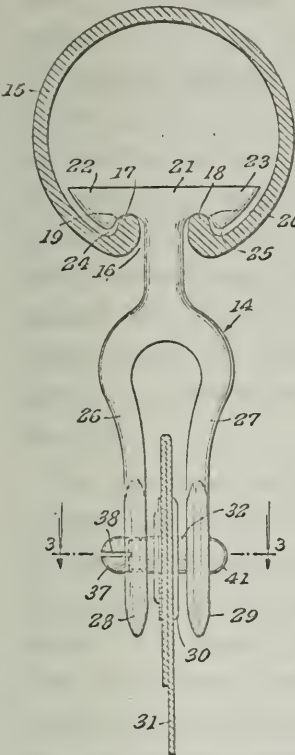


Fig. 2.

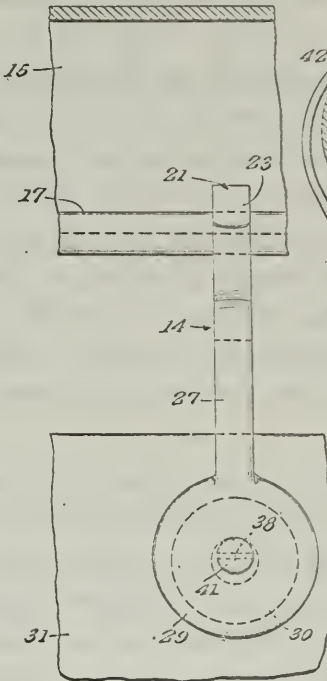


Fig. 5.

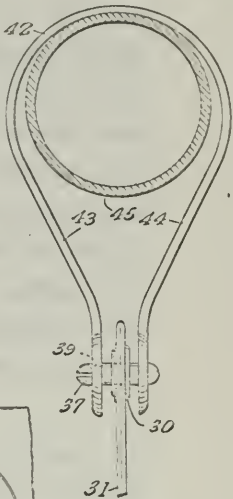


Fig. 3.

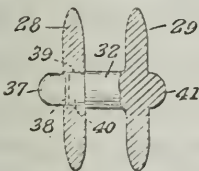


Fig. 6.

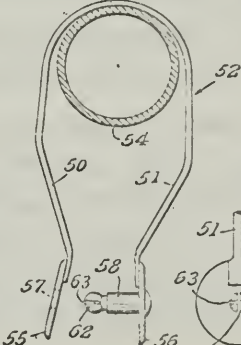


Fig. 7.

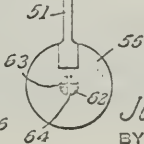


Fig. 4.

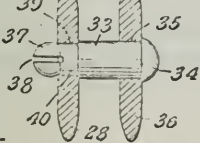
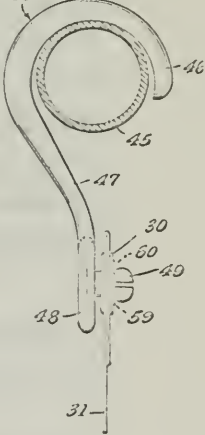


Fig. 8.



INVENTOR
Jacob Z. Silverman
BY
Harry J. Silverman
ATTORNEY

device is designed for use on shower curtains. No suggestion is made that the Silverman device has any utility with spring-pleated drapery. The curtain hook 14 attaches to the upper hem of the shower curtain 31 and has a T-shaped head 21. The head 21 can be secured to rod 15 by aligning the head with the slot 16, moving the head up into the rod and turning the curtain hook 90° to seat the recesses 19 and 20 of the head on the inwardly projecting rails 17 and 18 of the rod 15. The curtain hook can ride back and forth on the rails as the curtain is opened and closed, but the rails 17 and 18 engage the head recesses to restrain rotation of the curtain hook head "to prevent accidental displacement thereof from the rails."

The Silverman patent quite clearly does not show the combination of claim 3 of the Stubblefield patent in suit. It does not include a spring pleater, and, of course, does not suggest a combination wherein a glide is to be attached to a spring pleater so that the glide is free to turn in the track (contrary to the operation of Silverman) between crosswise positions wherein it will not fall out, nor where a twist of the wrist applied to a spring pleater will align the head with a track gap for insertion and a release of the spring pleater will automatically position the glide crosswise in the track.

As was stated by the Court in *Esco Corporation v. Hensley Equipment Company*, 265 F. Supp. 863 (D.C. N.D. Calif., 1965); affirmed 375 F.2d 432:

"The Court finds that while the pertinent features of each of claims 8 and 9 have appeared separately in prior art patents, the Court further finds that each

such patent has *less than the full combination of elements specified in either claims 8 or 9.*” (Emphasis by Court)

Plainly, the Silverman patent has less than the full combination specified in claim 3.

Plaintiffs’ Exhibit 40 was a specimen of the Silverman rod 14 with rails 17 and 18, and Exhibit 41 was a curtain with a spring pleater therein and glides as shown in the Silverman patent attached to the spring pleater. It was demonstrated that if the glides are not kept at right angles to the rod, but are turned relative thereto (as they must when the spring pleater is opened and closed), the glides do not slide freely back and forth in the track but instead bind therein, the binding being caused by the friction of the rails 17 and 18 in the glide heads (R. 512). When the drapery was moved to a closed position, the spring pleater twisted the glides in the rod so they fell out of the track (R. 513-514), releasing the drapery from the track.

Thus, not only does Silverman not suggest the claimed combination, the use of Silverman glides with spring-pleated draperies results in a combination having a different (as compared to the Silverman disclosure) and inoperative result.

Appellees introduced Exhibit AL, their version of the Silverman glide in which the T-shaped head was rotated 90° to the body of the glide, and Exhibit AM, a plurality of such glides secured to a standard piece of spring pleater with the heads of the glides riding in a piece of standard track (i.e., without the rails 17 and 18 as shown

in the Silverman rod 15). It was then demonstrated that the structure and functions of the elements combined in Exhibit AM were the same as that of claim 3 of the patent in suit.

The construction and operation of Exhibit AM, however, differs from the teachings of the Silverman patent in three distinct ways. First of all, the glide itself is significantly different because of the 90° turning of the head. As admitted by Mr. Stall, one of the appellees, if a glide as so modified were to be used in the Silverman set-up, the glides would fall out of the track as the curtain is pulled to a closed position, a result not desired by Silverman (R. 483-484).

Secondly, the use of the spring pleater of Exhibit AM is simply not suggested by Silverman, and, indeed, the combination of Silverman glides as shown in the Silverman patent with a spring pleater will not operate for the purpose desired by Silverman nor by the present invention, as demonstrated with Exhibits 40 and 41.

Thirdly, the use of a standard track, without rails, is not suggested by Silverman. Eliminating the rails, of course, allows the glides to turn easily in the track, which is essential to the present invention. However, in the Silverman patent, the rails 17 and 18 are specifically provided to prevent turning of the glides so that the glides cannot be accidentally dislodged from the rod.

Thus, Silverman teaches a particular structure and combination of a glide and rod wherein the rod cooperates with the rail to prevent the glide from turning. The present invention resides in a combination of a spring pleater, track and glides wherein the spring pleater turns

the glides freely in the track but limits the amount of turning so that the glides remain in the track during normal opening and closing of the drapery.

The Silverman patent does have one feature in common with the present invention. It does have a glide with a T-shaped head that can be inserted through the gap and then be turned to seat the head in the rod 15. However, this is about all that it does have in common, and, even then, the manner of insertion and seating of the Silverman glide is substantially different as compared to the present invention. In Silverman, the glide itself has to be handled manually by the installer as it is aligned and then has to be manually twisted to seat it in the rod. In the present invention the installer merely twists the spring pleater to align the glide head and moves the glide up through the track gap. The installer then releases the spring pleater and the spring pleater automatically orients the glide into a seated position.

Quite plainly, the Silverman patent does not anticipate the present invention defined by claim 3.

Topliff v. Topliff, 145 U.S. 156 (1891)

“It is not sufficient, in order to constitute an anticipation of a patented invention, that the device relied upon might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adapted, nor actually used for the performance of such function.”

The question then remains, would it have been obvious to one skilled in the art to take the Silverman glide out

of its environment, modify the construction thereof and give it a significantly new and different operation by using it with a spring pleater and track?

Mr. Stall, the developer in 1946 of the spring pleater (R. 470), has had twenty-one years of drapery hardware experience (R. 497), and throughout the years has seen about 50 different types of glides (R. 479). Surely he represents a reasonable standard of a person having "ordinary skill in the art". Yet, he did not develop his version of the present invention until after Mr. Stubblefield invented appellants' device and appellants were on the market with it.

More significantly, Mr. Stall testified that in his years of experience he had not seen a glide as shown in the Silverman patent (R. 487). When questioned about the purpose for the rails 17 and 18 of the Silverman rod 15 and whether the Silverman glide rotates about its vertical axis as the curtain is opened and closed, Mr. Stall was unable to answer, and stated that he did not know (R. 485-489).

Thus, we have here a 1943 prior art patent, issued several years prior to the development in 1946 of spring-pleated drapery and 17 years prior to the present invention, the operation of which was unclear to Mr. Stall. And yet (after full knowledge of the construction and operation of the Stubblefield patent in suit), appellees would have it believed that it would be obvious to take one element (the curtain hook 14) from the Silverman patent, modify it physically and put it into a new and different environment wherein it has new and additional cooperative results.

Appellees' conversion of the long dormant Silverman device into use with a spring pleater, after full knowledge of the manner of operation of the Stubblefield patent in suit, represents a clear and improper exercise of hindsight.

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U.S. 428, 31 S.Ct. 444 (1910)

“* * * Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skilful attention.”

Neff Instrument Corporation v. Cohu Electronics, Inc., 298 F.2d 82 (C.A. 9, 1961)

“* * * As to the obviousness of an invention, when viewed with the wisdom of hindsight, this court has said,

“‘It is of no significance that “viewed after the event, the means * * * adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention.” *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 274 (64 S.Ct. 593, 88 L. Ed. 721) * * *. “Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit.” ’ ’ ’

The finding and conclusion of obviousness based upon the Silverman patent should clearly be reversed.

(No Model.)

F. C. LOUNSBURY.
CURTAIN FIXTURE.

No. 568,091.

Patented Sept. 22, 1896.

Fig. 3.

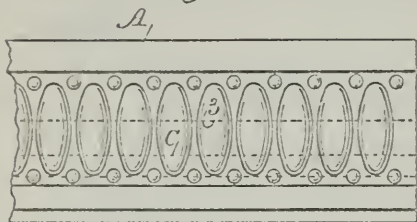


Fig. 1.

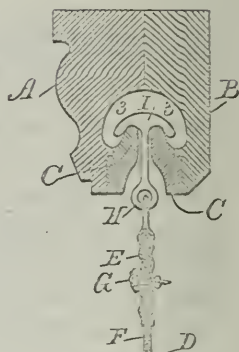


Fig. 4.



Fig. 2.

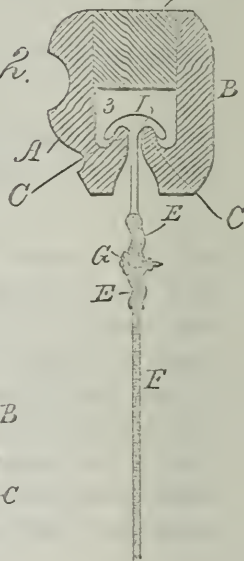
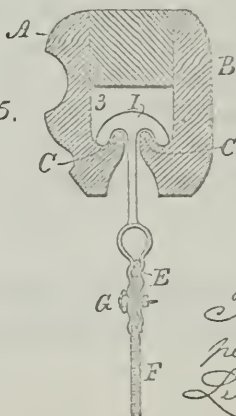


Fig. 5.



Witnesses

Char H. Smith
J. Staib

Inventor

Fred C. Lounsbury
per
Lounsbury & Co.

**THE INVENTION OF CLAIMS 3 AND 4 IS NOT OBVIOUS IN
VIEW OF THE LOUNSBURY PATENT NO. 568,091**

Appellees also relied heavily at the trial upon the Lounsbury patent No. 568,091 shown in Insert No. 5 on the opposite page.

This patent, issued 72 years ago, is substantially the same as the Silverman patent. That is, it too discloses a curtain hook I having a T-shaped head which can pass up through the gap between tracks c, c, and be turned 90° to seat on the tracks. The hook I is attached to the curtain F by means of a clip E and pin G so that the head of the hook I is at right angles to the curtain, as in Silverman. Three versions are shown in Lounsbury, Fig. 1 showing the hook I and clip E as two pieces with the clip suspended from the hook eye H, while in Figs. 2 and 5 the hook I and clip E are integral with each other.

As in Silverman, once the hook is inserted in the tracks, the tracks keep the hook from turning as the hooks move back and forth along the tracks upon opening and closing of the curtain.

Also as in Silverman, there is no disclosure or suggestion in Lounsbury as to the use of a spring pleater, and thus this patent does not show the combination of claim 3.

At the trial appellees introduced Exhibit AO to show how the Lounsbury disclosure could be changed into a device having the same operation as the present invention. Exhibit AO comprises a plurality of glides shaped the same as the hook I (but without the clip E) of Fig. 1 of the Lounsbury patent, with the hook eyes H being directly connected to a spring pleater and with the heads

of the hooks riding in a section of standard drapery track.

Such a combination is completely foreign to the Lounsbury disclosure. There is no suggestion in Lounsbury that the clip E of Fig. 1 could be eliminated and a curtain or drapery be attached directly to the hook eye H. In fact, if Lounsbury were to do this, as the curtain is pulled closed, i.e., to the position of the curtain in Fig. 1, the curtain would twist the hook so that it would bind severely or drop out, just as in Silverman (R. 523, 524). Thus, the first step of modification would render the Lounsbury device as inoperative for Lounsbury's purposes.

Next, the combination adds a spring pleater, which is completely unsuggested by Lounsbury. This addition would then require that the Lounsbury hooks turn about a vertical axis as they move along the track, an operation contrary to that desired by Lounsbury.

The next step of reconstruction is to substitute a track without inwardly turned lips for that shown by Lounsbury. This then allows the hooks to turn freely in the track, which again is a contrary result to that desired by Lounsbury. The elimination of such lips in the Lounsbury track would then eliminate the means whereby the hooks are held in the track.

It may well be that when all of these changes have been made, the new combination of a spring pleater, a portion only of the Lounsbury hooks I and a standard track will operate in substantially the same way as the Stubblefield patent, but such construction is certainly not suggested (and indeed is contrary to that shown) in

Lounsbury. It is only shown by Stubblefield. Again, this is a pure exercise of hindsight.

The testimony of Mr. Stall on the Lounsbury patent is also illuminating. He stated that he had read the patent in the past but that he didn't know how the drape was attached in the patent (R. 493), and didn't know whether the rotation of the Lounsbury hook portion in Exhibit AO as the spring pleater is moved was the same or different as shown in the Lounsbury patent (R. 496). Thus, we have a man skilled in the art who is not clear from the Lounsbury patent as to how the Lounsbury device is intended to operate. How, then, can it be obvious to take this ancient disclosure and make all of the modifications necessary to arrive at Exhibit AO, without using the knowledge taught only by the Stubblefield patent?

THE INVENTION IN THE PRESENT CASE IS NOT MERELY A GLIDE WITH A T-SHAPED HEAD, IT IS A COMBINATION OF ELEMENTS OBTAINING RESULTS THAT ARE NEW AND DIFFERENT FROM THOSE OBTAINED BEFORE

The Silverman and Lounsbury patents, of course, both show curtain hooks with a T-shaped head which can be manually inserted through a track and manually twisted to a seated position. However, this is not the sole contribution of Stubblefield.

Instead, claim 3 sets forth a combination of a spring pleater, a plurality of glides and a track. These cooperate, as mentioned before, so that:

- (1) no handling of the glides is necessary for installation or removal;

- (2) a mere twist of the spring pleater will align the head of the glide so it can be inserted or removed from the track;
- (3) after insertion of a glide into the track, a release of the spring pleater will automatically orient the glide in the track so that it will not fall out;
- (4) movement of the spring pleater will cause the glides to turn in the track as they move back and forth in the track, but will maintain the glide sufficiently crosswise at all times so that the glides will not fall from the tracks.

These functions are not achieved by any of the prior art devices actually in use in the spring-pleated drapery art. Neither are they shown nor suggested by the Silverman or Lounsbury patents. Moreover, if the Silverman or Lounsbury curtain hooks were to be connected to spring-pleated drapery in the manner in which Silverman and Lounsbury teach that their hooks should be connected to curtains, then the resulting combinations would be inoperative. The prior art, taken singly or in the combination suggested thereby, simply does not teach the combination of claim 3 and does not render such combination obvious.

The worth of the present invention has been properly assessed by the Court below: "What has been done here is very beneficial. I do not think there is any question about that. It is an advance in the art, and there is no question about that" (R. 654). Such an invention is clearly worthy of protection, and this case calls for the application of the doctrine set forth in *Reynolds v. Whitin Mach. Works*, 167 F.2d 78, 82 (C.A. 4, 1948):

“* * * Patents for useful inventions ought not to be invalidated and held for nought because of such excursions into the boneyard of failures and abandoned experiments.”

THE DISTRICT COURT ERRED IN ADOPTING FINDING OF FACT NO. 21 IN FULL. (SPECIFICATION OF ERROR NO. 3)

Finding of Fact No. 21 (Tr. 275) reads as follows:

“In April, 1961 . . . after the filing of the application which matured into the patent in suit . . . the plaintiff John H. Hancock displayed a specimen of the Stubblefield glide (shown in the patent in suit) to the defendant Stall. This was the first time that the defendant Stall saw a Stubblefield glide.”

The last sentence of this finding is clearly erroneous, and is not based on any credible testimony.

The facts show the following sequence of events. In August of 1960, Mr. Stubblefield had conceived his invention and a drawing, Exhibit 14, had been made for a mold to be made (R. 75). Appellants first sold these glides in October of 1960 (Exhibit 43) and by December 2, 1960 over 5000 glides as shown in the Stubblefield patent had been sold in the greater Los Angeles area (R. 601-602, Ex. 43).

The December 2, 1960 shipment of glides was made to Beauti Pleat of Long Beach and was signed for by a Norman Steffen (R. 562, 603, Exs. 42 and 43). Mr. Steffen testified that at this time he was working part time for his father (Beauti Pleat of Long Beach) as a drapery installer, and part time for appellee, Mr. Stall, in the latter's shop (R. 556).

Mr. Steffen testified that prior to the December 2, 1960 delivery of Stubblefield glides Mr. Stall had showed him and Mr. Scheel (Mr. Stall's foreman) a Stubblefield glide, had demonstrated its use with a spring pleater and track and had asked Mr. Scheel to work on making one like it (R. 570, 587-588).

The first physical evidence showing when appellees' glides (as used in the accused combination) were made is Exhibit AI, a bid dated February 8, 1961 for making a mold to produce appellees' glides.

The only evidence to support the finding that Mr. Stall did not see a Stubblefield glide before April, 1961 is Mr. Stall's testimony that he went to see his mold maker sometime prior to February 8, 1961 (R. 426) and that he had not seen a Stubblefield glide prior to that time (R. 423).

However, in Mr. Stall's deposition (Ex. 35), he testified that he first learned of the existence of the Stubblefield glide in late 1960 (R. 415). (This date had originally been "1961" in the deposition, but it was later changed to "1960", the change being initialled by Mr. Stall, R. 416.) Also, in Mr. Stall's deposition he testified that he had seen the Stubblefield glide *prior* to going to his mold maker (R. 423-424).

Thus, the only evidence to support the objected-to portion of Finding of Fact No. 21 is Mr. Stall's testimony at the trial which is in direct conflict with his deposition testimony that he saw the Stubblefield glide in late 1960, which is the time that Mr. Steffen testified that Mr. Stall showed and demonstrated the Stubblefield glide to him.

In addition, the evidence shows that the glides then developed by appellees' and appellants glides operated in combination with a spring pleater and track in such manner as to lead the Court to say that they "operate in exactly the same way" and "produce the same results" as appellants' glide (R. 633). Every portion of the fairly lengthy claim 3 fully describes appellants' accused combination (R. 200-215). This happenstance of such similarity is too much to be a pure coincidence. Insofar as Finding of Fact No. 21 states that the first time Mr. Stall saw a Stubblefield glide was in April, 1961 it is clearly erroneous.

Even though knowledge or intent to copy has no bearing on whether or not infringement exists, a true consideration of this finding has bearing on the question of validity. Mr. Stall was one skilled in the art. His lack of success in finding a solution to the problem before Mr. Stubblefield's invention, and his desire to have Mr. Scheel make glides to do the same job as the Stubblefield glides, clearly demonstrate the unobviousness of the present invention.

Sel-O-Rak Corp. v. Henry Hanger & Display Fix. Corp., 232 F.2d 176, 178 (C.A. 5, 1956)

"Recognizing, as we do, that the validity of a patent is tested by consideration of the statutory purpose as it affects the public as a whole rather than on the basis of the rights or interests of only the parties to specific litigation, we are nevertheless impressed by the recognition thus given to the essential contentions of the inventor by one who has vital commercial interests at stake, and whose attitude may be considered as fairly representing the indus-

try. As was said by the Court of Appeals for the Second Circuit in *Kurtz v. Belle Hat Lining Co.*, and quoted approvingly in two decisions of the Fourth Circuit:

“ ‘The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think.’ ”

THE DISTRICT COURT ERRED IN REFUSING TO DISMISS THE COUNTERCLAIM INsofar AS IT RELATES TO CLAIMS 1 AND 2. (SPECIFICATION OF ERROR NO. 4)

As has been brought out in the Statement of the Case, appellants made a general charge of infringement, without referring specifically to any claim, and appellees filed a counterclaim seeking to have all claims held invalid. Appellants in the discovery period narrowed their charge of infringement to claim 3 alone and thereafter all pleadings referred to claim 3 alone.

At the trial, appellees urged the Court to adjudicate claims 1 and 2. Appellants moved to dismiss the portion of the counterclaim relating to claims 1 and 2 on the basis that there is no case or controversy concerning such claims (R. 163), which motion was denied (R. 166).

Claims 1 and 2 differ significantly in scope from claim 3. As brought out previously, claim 3 relates to a combination of a spring pleater, glides and a track. Claims

1 and 2 relate not to such a combination, but solely to a glide of the specific construction shown in the patent in suit. Claims 1 and 2 read as follows:

1. A combination glide and pin element for draperies, which comprises a plastic body having a fulcrum portion and also having a dependent portion, pin-seat means provided on said dependent portion in spaced relationship from said fulcrum portion, said pin-seat means extending laterally from said dependent portion, glide means provided on said body above said fulcrum portion to slidably support said body from a drapery track, a resilient pin pivotally mounted on said fulcrum portion, said pin having a first portion adapted to be supportingly connected to a drapery, said pin also having a second portion adapted to pivot freely on one side of said pin-seat means, and means on said body to prevent movement of said second pin portion to the other side of said pin-seat means except upon flexing of said second pin portion around the distal end of said pin-seat means, whereby said second pin portion is resiliently maintained in locked condition on said other side of said pin-seat means.

2. The invention as claimed in claim 1, wherein a detent protrusion is provided at said distal end of said pin-seat means.

As far as the present case is concerned, there is no justiciable controversy between the parties requiring an adjudication of the validity or infringement of claims 1 and 2. The pleadings prior to trial specifically limited the charge of infringement to claim 3. By virtue of this, appellants have disclaimed any right to hereafter assert that appellees' glides infringe claims 1 and 2.

Du Bois Plastic Prod. v. United States Safety Service Co., 168 F. Supp. 944, 946 (D.C. Mo., 1958)

“Following service on it in this action, defendant filed a motion for a more definite statement, seeking, among other things, ‘a statement and designation of the patent claim or claims of each of the patents in suit with respect to which plaintiffs charge infringement in the complaint.’ Without awaiting formal ruling by the Court upon said motion, plaintiffs filed a more definite statement of complaint, designating the claims relied upon in this action to be: Claims 1, 2, 3, 4 and 5 of Patent No. 2,368,750; Claims 1, 2, 4, 5, 7, 8 and 9 of Patent No. 2,406,998; and Claims 1, 2, 3 and 6 of Patent No. 2,422,534. Plaintiffs have now filed an ‘amendment to the more definite statement of complaint’ and seek the Court’s approval of the withdrawal from this action of Claims 8 and 9 of Patent No. 2,406,998; and Claims 1, 2 and 6 of Patent No. 2,422,534. Defendant-counterclaimant opposes approval of the withdrawal by plaintiffs of any of the claims previously designated and alleged as being infringed by it on the ground that it is entitled to the protection of a judgment of non-infringement with respect to said claims. Notwithstanding defendant’s opposition, we believe that leave should be granted plaintiffs to file withdrawal from this action of the above-referred-to claims, for manifestly plaintiffs’ disclaimer of non-infringement thereof no longer presents any justiciable issue between the parties in respect thereto. In light of such written disclaimer, there is no reason for conditioning leave to withdraw such claims, with prejudice or otherwise. The legal effect of the withdrawal is a disclaimer of infringement of said claims by defendant, and that fact standing of record will prevent plaintiffs from

hereafter asserting future infringement by defendant of any matters previously put in issue by the pleadings in respect to said claims.”

Also see:

Yavitch v. Seewack, 323 F.2d 561 (C.A. 9, 1963)

Emerson v. National Cylinder Gas Co., 251 F.2d 152, 157 (C.A. 1, 1958)

The Peelers Company v. Kaakinen, 126 USPQ 42 (D.C. W.D. Washington, 1960)

For the reasons set forth in the above cases and because there was and is no justiciable controversy between the parties relating to claims 1 and 2, the motion to dismiss was erroneously denied.

THE DISTRICT COURT ERRED IN HOLDING CLAIMS 1 AND 2 TO BE INVALID. (SPECIFICATION OF ERROR NO. 5)

Although appellees asserted at the beginning of the trial that claims 1 and 2 should be adjudicated (R. 11), appellees did not pursue this during the trial. No prior art was introduced with testimony to explain how such art invalidated claims 1 and 2. In fact, there is no testimony concerning claims 1 and 2 at all. During the final arguments, appellees' counsel completely disregarded claims 1 and 2.

As is apparent from a reading of claims 1 and 2, many specific limitations are set forth as to the precise construction of the body portion of the glide and the manner in which the pin cooperates therewith. In the Findings of Fact, Finding No. 27 (Tr. 276) is the only one

which sets forth the "reasoning" as to why these claims are invalid:

"27. The glide defined by each of claims 1 and 2 of Patent No. 3,090,431 does not constitute an invention over the prior art as aforesaid; the resilient pin attachment means is merely a change in degree for accomplishing the same result. The construction defined by each of Claims 1 and 2, taken as a whole, would have been obvious at the time the alleged invention was made in 1960 to a person having ordinary skill in the drapery hardware art."

There is no evidence at all to support the finding that the resilient pin attachment is merely a matter of degree. In addition, this finding is clearly insufficient to support a conclusion of invalidity in that it is not detailed enough to advise of the difference between the claimed invention and the prior art, nor does it show how or in what manner or respect the claimed inventions were not inventions, or how and why they did not require any exercise of the inventive faculties for their production. Rule 52(a), F.R.C.P., *Yavitch v. Seewack*, 323 F.2d 561 (C.A. 9, 1963); *Welsh Co. of Calif. v. Strolee of California*, 313 F.2d 923 (C.A. 9, 1963).

The judgment of invalidity of claims 1 and 2 should accordingly be stricken.

**THE DISTRICT COURT ERRED IN HOLDING THAT THE PATENT
IN SUIT HAD BEEN MISUSED. (SPECIFICATION OF ERROR
NO 6)**

The Court below concluded as a matter of law (Conclusion of Law No. XI, Tr. 290) that appellants were guilty of patent misuse.

The basis for the alleged misuse is bottomed upon Exhibit P, an agreement between appellant Stubblefield, Hancock and Brooks on the one hand and appellant Spring Crest. In this agreement, Stubblefield et al. granted an exclusive license under "Patent Rights" which included the patent in suit, several other patents and "all inventions conceived by any of them and constituting improvements or modifications relative to any invention contained within said Patent Rights or relating to drapery hardware and drapery hardware accessories". Stubblefield et al. also agreed to disclose to Spring Crest "all ideas conceived by any of them and relating to the field of drapery hardware and drapery hardware accessories."

In return, Stubblefield et al. were to be paid a royalty based upon the sale of certain specific items enumerated in Schedule A to the agreement. Some of these items were covered by patents, most were not. Stubblefield also agreed not to license or induce anyone other than Spring Crest to manufacture, use or sell the items enumerated in Schedule A.

During the trial appellees argued that this license agreement is a classic example of patent misuse wherein the owners of the patent in suit (Stubblefield, Brooks and Hancock) used the patent to force Spring Crest to pay royalties on unpatented items.

During the testimony, however, it was brought out that Mr. Stubblefield designed, in whole or in part, each and every item on Schedule A, that at the time they were designed Mr. Stubblefield was not an employee of Spring Crest, and that these royalties were the only compensation for this design work that he had done for Spring Crest (R. 598-599). Thus the agreement represents nothing more than an agreement by Spring Crest to pay for patented and unpatented design work done for it by Mr. Stubblefield, coupled with an agreement on the part of Stubblefield that Spring Crest was to have exclusive rights to these designs as far as he was concerned.

More important to the question of misuse is the fact that there was never any refusal by Stubblefield et al. to license Spring Crest under the patent in suit until Spring Crest agreed to pay royalties on all of the items in Schedule A, nor did Spring Crest ever seek a license in which it would not have to pay royalties on the items in Schedule A (R. 599-600).

Under these facts, it is plain that the parties entered into an agreement that they desired and that there was no coercion exercised whatsoever based upon the existence of the patent in suit. Appellants know of no law nor reason why this transaction between themselves can be tortured into a "patent misuse" as to give rise to any benefits to appellees.

Further, it is plain that the Court below did not intend to hold that there has been patent misuse. After requesting that appellees prepare the findings, the following colloquy was had:

“Mr. Wills: Your Honor, would the Court care to make a finding on the patent misuse?

The Court: No. * * *” (R. 668)

The holding that patent misuse exists should be reversed as inadvertently entered and as not based on fact or law.

**THE DISTRICT COURT ERRED IN FAILING TO FIND THAT
CLAIM 3 WAS INFRINGED. (SPECIFICATION OF ERROR
NO. 7)**

At the trial the accused combination (Exhibits 25 and 26) was thoroughly demonstrated, the language of claim 3 was applied to it and it was clearly shown that it had substantially the same construction, operating in the same way to give the same results (R. 200-215).

There was no dispute as to how either the accused or patented combinations worked, and there was no testimony offered by appellees to show that there was no infringement. The Court stated during the trial that in combination the two “operate in exactly the same way” and “produce exactly the same results” (R. 633).

In order to pass upon the issues presented and avoid the possibility of a remand for a determination of the question of infringement, the Court should have held that infringement exists if the claim is valid, and it was error not to do so.

However, in the present case, it is submitted that a remand is not necessary and that this Court can decide the question of infringement. There is no dispute as to

During the testimony, however, it was brought out that Mr. Stubblefield designed, in whole or in part, each and every item on Schedule A, that at the time they were designed Mr. Stubblefield was not an employee of Spring Crest, and that these royalties were the only compensation for this design work that he had done for Spring Crest (R. 598-599). Thus the agreement represents nothing more than an agreement by Spring Crest to pay for patented and unpatented design work done for it by Mr. Stubblefield, coupled with an agreement on the part of Stubblefield that Spring Crest was to have exclusive rights to these designs as far as he was concerned.

More important to the question of misuse is the fact that there was never any refusal by Stubblefield et al. to license Spring Crest under the patent in suit until Spring Crest agreed to pay royalties on all of the items in Schedule A, nor did Spring Crest ever seek a license in which it would not have to pay royalties on the items in Schedule A (R. 599-600).

Under these facts, it is plain that the parties entered into an agreement that they desired and that there was no coercion exercised whatsoever based upon the existence of the patent in suit. Appellants know of no law nor reason why this transaction between themselves can be tortured into a "patent misuse" as to give rise to any benefits to appellees.

Further, it is plain that the Court below did not intend to hold that there has been patent misuse. After requesting that appellees prepare the findings, the following colloquy was had:

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The Court: No. * * *” (R. 668)

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In order to pass upon the issues presented and avoid the possibility of a remand for a determination of the question of infringement, the Court should have held that infringement exists if the claim is valid, and it was error not to do so.

However, in the present case, it is submitted that a remand is not necessary and that this Court can decide the question of infringement. There is no dispute as to

the structures involved nor their manner of operation, and thus the question of infringement becomes a question of law that may be decided by this Court. *United States v. Esnault-Pelterie*, 303 U.S. 26, 30, 50 S.Ct. 412; *Stuart Oxygen Co. v. Josephian*, 162 F.2d 857 (C.A. 9, 1947).

In view of the fact that the testimony (R. 200-215) and evidence show that infringement plainly exists and that such testimony was not disputed by appellees, we submit that this Court should decide, as a question of law, that appellees have infringed claim 3.

CONCLUSION

Appellants respectfully request this Court to reverse the judgment below as to claims 3 and 4, to strike the portion of the judgment as to claims 1 and 2, to reverse the holding of patent misuse and to hold that claim 3 of the patent in suit is valid and infringed by appellees.

Dated, San Francisco, California,

June 14, 1968.

Respectfully submitted,

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CERTIFICATE OF CONFORMANCE

I hereby certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and, in my opinion, the foregoing brief is in full compliance with those rules.

CARLISLE M. MOORE.

(Appendix Follows)

Appendix

Appendix

APPELLANTS' EXHIBITS

Exhibit Number	Identified	Offered	Received	Rejected
1	7	7	7	
2	20	20	20	
3	20	20	21	
4	23	23	23	
5	24	24	24	
6	24	25	24	
7	30	30	30	
8	31	32	32	
9	35	35	36	
10	36	36	37	
11	42	42	42	
12	42	42	42	
13	43	43	43	
14	74	75	76	
15	77	85	85	
16	85	85	85	
17	86	86	86	
18	89	89	89	
19	99	103	103	
19A	134	134	134	
20	102	103	103	
21	133	135	135	
22	133	136	136	
23	133	137	137	
24	147	148	148	
25	147	151	151	
26	152	153	153	
26A	152	153	153	
27	167	167	167	
28	167	167	167	
29	168	168	178	
30	251	253	254	
31	265	265	265	
32	265	266	266	
33	270	270	270	
34	271	271	271	
35	283	283	283	
36	284	284	285	
37	360	360	360	
38	507	510	510	
39	507	510	510	
40	507	526	527	
41	507	526	527	
42	562	563	563	
43	600	603	603	

APPELLEES' EXHIBITS

Exhibit Number	Identified	Offered	Received	Rejected
A	447	447	447	
B	448	448	448	
C	442	442	442	
D	307	307	307	
E	230	231	231	
F	305	449	449	
G	449	449	449	
H	380	450	450	
I	376	379	379	
J	450	450	451	
K	217	217	218	
L	218	218	218	
M	339	339	339	
N	340	340	340	
O	451	451	451	
P	443	443	443	
Q	444	444	444	
R	315	315	315	
S	277	278	278	
T	388	388	388	
U	115	115	116	
V	17	17	18	
W	452	452	452	
X	298	298	298	
Y	304	453	453	
Z	319	319	319	
AA	320	320	321	
AB	324	324	—	326
AC	326	—	—	
AD	327	327	328	
AE	323	323	323	
AF	336	336	336	
AG	397	397	397	
AH	345	346	346	
AI	391	397	397	
AJ	391	397	397	
AK	466	467	467	
AL	467	469	469	
AM	469	474	474	
AN	474	475	475	
AO	475	478	478	